

## REMARKS

### I. Introduction

In response to the Office Action dated April 25, 2006, which was made final, and in conjunction with the Request for Continued Examination (RCE) submitted herewith, claims 2-3, 24-25 and 46-47 have been canceled, and claims 1, 23, 27 and 45 have been amended. Claims 1, 4-23, 26-45 and 48-66 remain in the application. Re-examination and re-consideration of the application, as amended, is requested.

### II. Objections to the 131 Declarations

Beginning on page 2, the Office Action objects to the previously submitted Declarations under 37 C.F.R. §1.131, and asserts that they are insufficient to overcome the prior art rejections on a number of grounds.

Each of these objections are addressed in turn below.

1. The Office Action asserts that the Declaration by Applicant's attorney (George H. Gates) is not eligible for consideration. Applicant's attorney disagrees. M.P.E.P. §2138.04 states that the diligence of the attorney in preparing and filing patent application inures to the benefit of the inventor. Consequently, Applicant's attorney submits that his declaration, and the Declaration under 37 C.F.R. §1.131 by Jeanette Berry Souza submitted herewith, should be considered by the Examiner, as they supplement the Declaration submitted by the inventor.

2. In addition, the Office Action asserts that the evidence submitted is insufficient to establish diligence from prior to the reference date to the filing date of the application. Specifically, the Office Action notes that the declaration states that, during the time period between an unspecified date (the date that the present invention was "rated," sometime before June 21, 2000) and May 8, 2001 (the date that the IBM Intellectual Property Law Department made a "final" decision to file a patent application for the present invention), a patentability search and a "filing determination" were conducted. However, the Office Action complains that the declaration gives no details about how long the patentability search took or what was searched, and that the declaration also gives no details about the steps involved in the "filing determination" or how long the "filing determination" took. The Office Action states that in 323 days (the time period between June 20, 2000 and May 8, 2001), a patentability search and a "filing determination" were conducted, but this is insufficient proof of due diligence.

Applicant's attorney submits herewith the Declaration under 37 C.F.R. §1.131 by Jeanette Berry Souza to identify particular dates regarding the patentability search and filing determination.

As noted above, M.P.E.P. §2138.04 states that the diligence of the attorney in preparing and filing patent application inures to the benefit of the inventor. M.P.E.P. §2138.04 further states that reasonable diligence is all that is required of the attorney, and reasonable diligence is established if attorney worked reasonably hard on the application during the continuous critical period. According to M.P.E.P. §2138.04, if the attorney has a reasonable backlog of unrelated cases which he takes up in chronological order and carries out expeditiously, that is sufficient.

Applicant's attorney submits that his declaration shows reasonable diligence. In addition, Applicant's attorney submits that the Declaration under 37 C.F.R. §1.131 by Jeanette Berry Souza further describing the continuous efforts involved in the constructive reduction to practice of the present application also shows reasonable diligence. In light of these facts, Applicant's attorney submits that the declarations provide sufficient evidence of a diligent reduction to practice.

3. Finally, the Office Action also asserts the following:

Moreover, the declaration and the exhibits fail to show that the invention actually existed and worked for its intended purpose. The declaration fails to point out where each limitation of the claims is proven to exist and work for its intended purpose in the exhibits. In other words, the declaration fails to map the recited claim limitations to those portions of the exhibits that demonstrate the invention existed and worked for its intended purpose.

The declaration states that the "Disclosure" document (i.e., one of the exhibits) describes the invention and fully supports the claims (see Statement 2b). However, that statement fails to point out how the "Disclosure" document proves that each limitation of the claimed invention existed and worked for its intended purpose. Stated differently, Statement 2b fails to demonstrate which parts of the "Disclosure" document prove that each limitation of the claimed invention existed and worked for its intended purpose. Additionally, the declaration fails to mention any details regarding the development of the software and the testing of the software to ensure that it worked for its intended purpose.

The declaration and exhibits must clearly explain which facts or data Applicant is relying on to show completion of her invention prior to the particular date. Each exhibit relied upon should be specifically referred to in the declaration, in terms of what it is

Applicant's attorney notes that the declarations are intended to show conception and diligent to reduction to practice, where the reduction to practice is a constructive reduction to practice, i.e., the filing of the present application. Consequently, the Office Action errs when it asserts that the declarations and the exhibits need to show that the invention "actually existed and worked for its

intended purpose,” or that the declaration and exhibits must clearly explain which facts or data Applicant is relying on to show “completion of her invention prior to the particular date.”

On the other hand, if the Office Action is asserting that the declaration fails to prove conception of the invention, then Applicant’s attorney respectfully traverses this assertion.

Consider independent claim 1, which is set forth below:

1. A computer-implemented method for identifying and distinguishing words contained within an electronic message, comprising the steps of:

(a) creating and reading electronic messages in an electronic messaging application performed by a computer, wherein the electronic messaging application sends an electronic message from an originator to a recipient via a network, and the electronic messaging application identifies and distinguishes certain words that are contained within the electronic message by performing the steps of:

(1) comparing message terms in an electronic message to significant terms stored by the computer in an online registry to identify any of the message terms in the electronic message that match the significant terms stored in the online registry; and

(2) making alterations to the electronic message to identify the matched message terms and to indicate their significance to a reader, wherein the alterations are made by the electronic messaging application when the electronic message is authored by its originator or received by its recipient.

Applicant’s attorney notes that support for this claim can be found in the exhibit at the following locations:

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The present invention is a method and system for easily identifying and distinguishing words contained within an e-mail message in order to convey significance to the recipient of the message The present invention relates to creating and reading e-mail messages.

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Authors of e-mail messages can easily find terms in their messages for which they want to call attention to when read by the recipients and distinguish those terms so that they are readily visible to those particular recipients. This reduces the likelihood of a recipient overlooking something in the message that the author wants them to read.

Individual recipients of the e-mail messages can easily find those terms in the message that are important to each of them. This reduces the time each person spends reading their e-mail, as they can scan each message and easily find the pieces that are important to them.

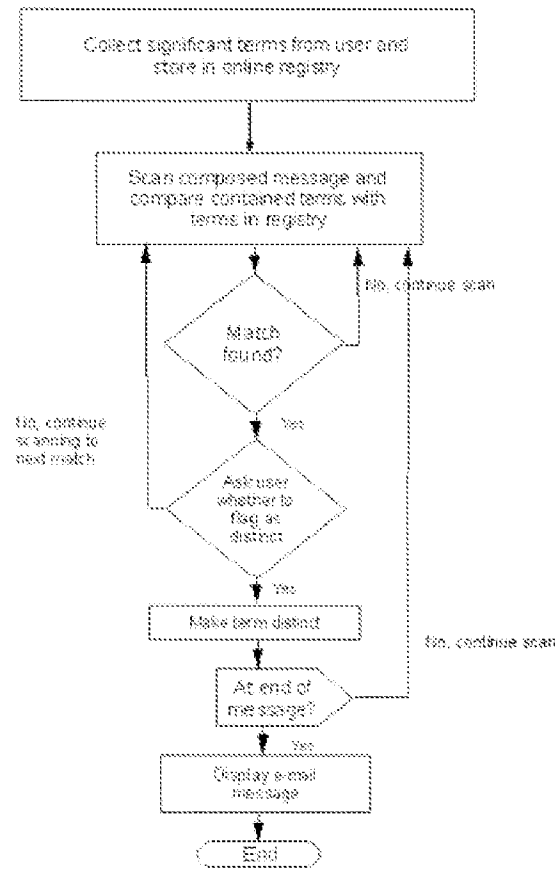
To address the requirements described above, the present invention discloses a method that includes: collecting significant terms, locating those terms inside an e-mail message, and, within the message itself, distinguishing them from the other “non-significant” terms so that they can be quickly and easily identified. With this method:

1) E-mail authors define a set of terms (which can be words, proper names, invented words) that they want to be registered as significant terms. When finished composing an e-mail message, the authors invoke the invention which scans the e-mail message and locates the registered terms in the body of the message. For each occurrence of a registered term, the invention asks the author whether it should make that occurrence to appear distinct within the message.

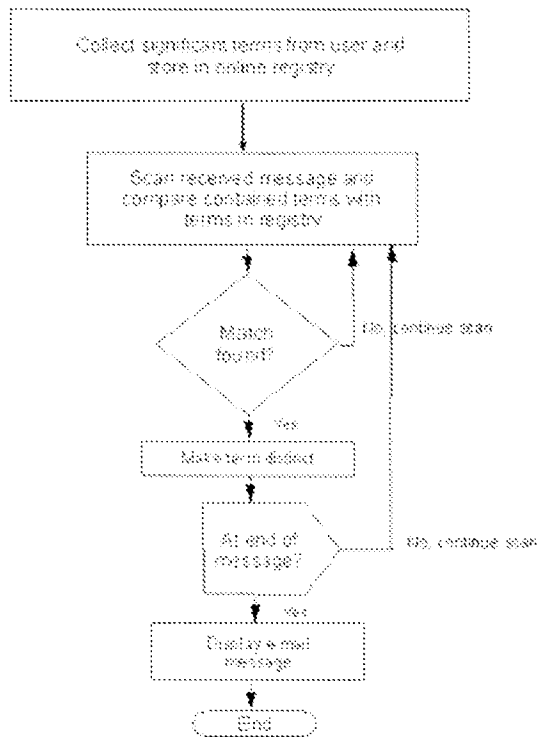
and

2) E-mail recipients define a set of terms (which can be words, proper names, invented words) that they want to be registered as significant terms. When they open an e-mail message to be read, the recipients invoke the invention which scans the e-mail message, locates the registered terms in the body of the message, and makes the occurrences appear distinct within the message.

(Figure 1, for email author)



(Figure 2, for email recipient)



Example 1: Embodiments used by Authors of e-mail messages

In the Lotus Notes e-mail product, provide an option off of the Edit menu named: "Collect key names/terms". This option would open a dialog where the user can select, type in, or otherwise specify terms of importance/significance; for example:

- Names of co-workers (could import these from the user's personal address book)
- Key product terms and names ("XYZ product", "Install Team", "Human Resources", etc.)

- Key words used in user's particular field ("XML", "HTML", etc.)

When the user is done in this dialog, a registry of these terms is built and kept on the user's machine.

Provide an option off of the Edit menu named: "Flag key names/terms". This option would be available when the user is composing a new e-mail message. This option would open a dialog similar to the spell-check window where the user can indicate that the embodiment of the invention should go through the e-mail message and flag in turn any term that matches any of the key names/terms at are in the registry collected earlier, or flag any names of people in the To: list that also appear in t body of the message. When a key term is flagged, the user has the option

in the dialog of specifying how to indicate that the term is significant; for example, make the term be a different font, make the term be a different color, add an image next to the term, attach a sound file on the term.

At the end of the process, the result is an e-mail message that has terms that are in different fonts and colors that signify to the recipients those places that they should pay attention to. Key names from the To: list are flagged in bright bold red at places where they have actions to do; different color for some people; bold font for status, install and build. Below, the author choose not to make bold every occurrence of “install” and “build”; just the ones where he thought it would make a difference:

Applicant’s attorney submits that the above portions of the exhibit fully support independent claim 1 (as well as the other claims). More specifically, Applicant’s attorney submits that the above portions of the exhibit prove that the Applicant possessed a complete conception of the invention prior to the effective date of the reference.

Thus, Applicant’s attorney submits that the Declarations under 37 C.F.R. §1.131 are proper and sufficient to overcome the prior art rejections. Consequently, Applicant’s attorney requests that these objections be withdrawn.

### III. Claim Objections

On page (5) of the Office Action, claims 4-7, 26-29 and 48-51 were objected to because of certain informalities.

Applicant’s attorney respectfully traverses these objections, and submits that the objected to use of the term “when” is proper and grammatical. Consequently, Applicant’s attorney requests that these objections be withdrawn.

### IV. Prior Art Rejections

#### A. The Office Action Rejections

On page (6) of the Office Action, claims 1, 8-16, 19-23, 30-38, 41-45, 52-60 and 63-66 were rejected under 35 U.S.C. §103(a) as being unpatentable over “Special Edition Using Microsoft Outlook 2002” (Padwick-Outlook 2002) in view of U.S. Publication No. 2004/0080528 (Rand). On page (16) of the Office Action, claims 2-7, 24-29 and 46-51 were rejected under 35 U.S.C. §103(a) as being unpatentable over Padwick-Outlook 2002, in view of Rand, and further in view of U.S. Patent No. 6,009,442 (Chen). On page (26) of the Office Action, claims 17, 18, 39, 40, 61 and 62 were rejected under 35 U.S.C. §103(a) as being unpatentable over Padwick-Outlook 2002, in view of Rand, and further in view of U.S. Publication No. 2003/0020749 (Abu-Hakima). On page (29) of

the Office Action, claims 1-16, 19-38, 41-60 and 63-66 were rejected under 35 U.S.C. §103(a) as being unpatentable over “Special Edition Using Microsoft Outlook 2000” (Padwick-Outlook 2000) in view of Chen. On page (47) of the Office Action, claims 17 and 18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Padwick-Outlook 2000, in view of Chen, and further in view of U.S. Patent No. 5,825,854 (Larson).

Applicant’s attorney respectfully traverses these rejections, in view of the amended claims above and the arguments below.

B. The Rejections Based on Padwick-Outlook 2002, Rand and/or Abu-Hakima

Applicant’s attorney submits that the previously-submitted Declaration under 37 C.F.R. §1.131 by inventor Lee Anne Kowalski and Declaration under 37 C.F.R. §1.131 by George H. Gates, supplemented by the Declaration under 37 C.F.R. §1.131 by Jeanette Berry Souza, taken together, eliminate Padwick-Outlook 2002, Rand and Abu-Hakima as references.

C. The Rejections Based on Padwick-Outlook 2000, Chen and/or Larson

As noted above, the Office Action also asserts that the combination of Padwick-Outlook 2000 and Chen renders obvious all the elements of the Applicant’s claims 1-16, 19-38, 41-60 and 63-66. Further, the Office Action asserts that the combination of Padwick-Outlook 2000, Chen and Larson renders obvious all the elements of the Applicant’s claims 17 and 18.

Applicant’s attorney submits that the claimed invention distinguishes over the references.

Specifically, the combination of references does not teach or suggest making alterations to the electronic message to identify the matched message terms and to indicate their significance, wherein the alterations are made by an electronic messaging application when the electronic message is authored by its originator or received by its recipient.

For example, the Office Action acknowledges that Padwick-Outlook 2000 fails to disclose making alterations to the electronic message to identify the matched message terms and to indicate their significance to a reader. Nonetheless, the Office Action asserts that Chen teaches these limitations. Further, the Office Action asserts that Chen teaches altering the electronic message when it is authored or received.

However, Chen explicitly states that emails or other documents must be imported into its document management system. See, col. 3, 37-59 of Chen. Moreover, Chen’s document management system is not an electronic messaging application. Consequently, Chen does not make



the alterations when the electronic message is authored by its originator or received by its recipient. Instead, Chen teaches functions that are performed only when the email has been imported into the document management system.

Larson fails to overcome the deficiencies of Padwick-Outlook 2000 and Chen. Recall that Larson was cited only against dependent claims 17 and 18, and only for teaching a telephone access system that inserts an audio file at a highlighted term of an electronic message.

Thus, even when combined, the references do not teach or suggest all the limitations of Applicants claims. Moreover, the various elements of Applicant's claimed invention together provide operational advantages over the references. In addition, Applicant's invention solves problems not recognized by the references.

As a result, Applicant's attorney submits that independent claims 1, 23, and 45 are allowable over Padwick-Outlook 2000 and Chen. Further, dependent claims 4-22, 26-44 and 48-66 are submitted to be allowable over Padwick-Outlook 2000, Chen and/or Larson in the same manner, because they are dependent on independent claims 1, 23, and 45, respectively, and thus contain all the limitations of the independent claims. In addition, dependent claims 4-22, 26-44 and 48-66 recite additional novel elements not shown by Padwick-Outlook 2000, Chen and/or Larson.

V. Conclusion

In view of the above, it is submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephone interview, the Examiner is urged to call Applicant's undersigned attorney.

Respectfully submitted,

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